

REMARKS

I. Status of the Claims

Claims 1, 2, 4-29, and 31 are pending in this application. No claims have been amended herein. Applicant acknowledges the withdrawal of the obviousness-type double patenting rejections and of the rejections under § 112, second paragraph, and the entry of the amendments set forth in Applicant's Reply filed April 10, 2003.

II. Rejection under 35 U.S.C. § 103(a)

In the Advisory Action dated April 28, 2003, the Examiner maintained the rejections of claims 1-2 and 4-31 under 35 U.S.C. §103(a) as being unpatentable over *DesLauriers* in view of *Anton*, *Konik*, or *Kimura* for the reasons set forth in the final Office Action dated January 21, 2003. Applicant respectfully continues to traverse these rejections.

Two of the basic criteria an Examiner must demonstrate in order to establish a prima facie case of obviousness are (1) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and (2) that there is a reasonable expectation of success in making the proposed modification. See M.P.E.P. § 2143. Neither of these two

criteria has been satisfied with respect to the modifications of *DesLauriers* proposed by the Examiner.

With respect to the first criterion, the Federal Circuit recently reaffirmed the Examiner's high burden to establish a prima facie case of obviousness and emphasized the requirement for specificity. In *In re Lee*, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be **based on objective evidence of record**. This precedent has been reinforced in myriad decisions, and **cannot be dispensed with**." 61 U.S.P.Q.2D (BNA) 1430, 277 F.3d 1338, 1433 (Fed. Cir. 2002) (emphasis added). Further, the Federal Circuit explained that

[t]he need for specificity pervades this authority...
the examiner can satisfy the burden of showing obviousness of the combination **only by showing some objective teaching** in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Id. (internal citations and quotation omitted) (emphasis added).

Further, "[t]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000).

Even when obviousness is based on a single prior art reference, there must be such a showing. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996). Accordingly, the

requirements discussed in In re Lee are equally applicable in cases where the Examiner proposes to modify a single reference. Moreover, the mere fact that references **can** be combined or modified does not render the resultant combination obvious unless the prior art **also suggests the desirability** of the combination.

See M.P.E.P. § 2143.01.

In the present case, the Examiner has failed to make a factual inquiry based on any objective evidence of record. Such an inquiry would reveal that there would have been no motivation to make the proposed modifications at the time the invention was made.

Claims 1, 2, and 4-26

Claim 1 is drawn to a composition comprising at least one linear dimethicone and at least one block copolymer film former chosen from tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, with the proviso that said composition comprises at least one tri-block copolymer film former, wherein said at least one block copolymer film former is present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition. *DesLauriers* does not teach such a composition nor does it provide the requisite motivation or suggestion, based on objective evidence of record, to ~~make the **specific combination** as claimed in the present claim 1.~~

In the Advisory Action, the Examiner asserts that "the amount[] of polymer disclosed in *DesLauriers* et al. is about 1-20%, which may be a mixture of several polymers including triblock copolymer. The claimed amount []substantially overlap[s] with such range." See Continuation Sheet. However, there is no motivation in *DesLauriers* to both (1) select the amount of at least one block copolymer film former to be an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition **and** (2) to combine this amount of the at least one block copolymer film former with at least one linear dimethicone. As discussed above, current Federal Circuit cases demand that the Examiner, in making an obviousness rejection, **show some objective teaching** in the cited reference that would **suggest the desirability** of the proposed modification. No such showing has been made in the present case.

For example, *DesLauriers*' broad recitation that "[w]hen formed into gels, the mixture or blend of copolymers, will comprise about 1 to 20 wt % of the total weight" fails to satisfy the Examiner's burden to set forth specific, objective evidence suggesting the modifications proposed by the Examiner. Moreover, *DesLauriers* continues in the very next sentence to teach that "[p]referably the total weight of polymer contained in the oil will range from about 5 to 15 wt %." See col. 6, lines 36-37. Accordingly, *DesLauriers* fails to suggest the desirability of selecting the amount of at least one block copolymer film former to be an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition.

In fact, *DesLauriers* teaches away from selecting the amount of at least one block copolymer film former to be an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition. This is evidenced at least by *DesLauriers*' examples. See e.g., Example 1 setting forth 9 compositions each comprising 5 wt % copolymer; Example 2 setting forth 12 compositions each comprising 5 wt % copolymer; Example 3 setting forth 5 compositions each comprising a total of 5 wt % copolymers, 2 compositions each comprising a total of 10 wt % copolymer, 2 compositions each comprising a total of 15 wt % copolymer, and 1 composition comprising 3.5 wt % copolymers; Example 4 setting forth 13 compositions each comprising 10 wt % copolymer(s); Example 5 setting forth 18 compositions each comprising 10 wt % copolymer(s); Example 6 setting forth compositions each comprising at least 2.5 wt % copolymers; and Example 7 setting forth compositions each comprising between 4.0 wt % and 6.0 wt % copolymers. A reference cannot be modified where it teaches away from the proposed modification.

DesLauriers also fails to suggest the desirability of combining dimethicone with from 0.139% to 1.953% by weight at least one block copolymer film former. As previously noted by Applicant, *DesLauriers* only discloses dimethicone once - in Table 11. However, the compositions in Table 11 comprise at least 2.5% by weight of at least one block copolymer. Moreover, the only composition comprising dimethicone and at least one block copolymer that did not exhibit separation comprised 2 wt% dimethicone and 4.9 wt% Kraton copolymers. If the concentration

of the dimethicone was increased, and the concentration of the Drakeol 5 composition comprising the block copolymers therefore decreased, separation of the sample occurred. Accordingly, *DesLauriers* teaches away from combining dimethicone with from 0.139% to 1.953% by weight at least one block copolymer film former.

In the Advisory Action, the Examiner asserts that "the data in table 11 merely show[s] that [dimethicone] may be not suitable for [use at] high concentration." See Continuation Sheet. However, the Examiner has not pointed to any objective evidence of record to support this assertion and, as such, this assertion is mere speculation. For example, it could equally be concluded that a high concentration of block copolymer film former is required when in the presence of any amount of dimethicone. Regardless, the objective evidence of record shows that *DesLauriers* did not even test compositions comprising less than 2.5 wt% block copolymers in combination with dimethicone. The objective evidence of record also shows that compositions comprising less than 4.9 wt% block copolymers in combination with dimethicone resulted in separation. Accordingly, based on the objective evidence of record, one of ordinary skill in the art would not have been motivated based on *DesLauriers'* data to combine only from 0.139% to 1.953% by weight of at least one block copolymer film former with dimethicone.

Accordingly, Applicant maintains that *DesLauriers* teaches away from compositions comprising dimethicone and at least one block copolymer film former

present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition as presently claimed. As the cited references do not remedy the deficiencies of *DesLauriers*, Applicant respectfully requests the withdrawal of this rejection at least with respect to claims 1, 2, and 4-26.

Claim 29

Claim 29 is drawn to a composition comprising, *inter alia*, at least one linear dimethicone, at least one cyclic dimethicone, and at least one block copolymer film former as presently claimed. Applicant maintains that, based on the objective evidence of record, one of ordinary skill in the art would not have been motivated to modify the compositions of *DesLauriers* in a manner to necessary arrive at a composition as presently claimed.

As previously discussed, *DesLauriers* only discloses a composition comprising dimethicone in Table 11. Table 11 compares the compatibility of gels with various components but does not suggest combining any of the tested components, let alone combining cyclomethicone and dimethicone. For example, cyclomethicone and dimethicone were the worst emollients tested in terms of sample separation. Accordingly, the objective evidence of record fails to support the present rejection. As with the rejection of claims 1, 2, and 4-26, the Examiner has failed to point to any objective teaching in *DesLauriers* that suggests the

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desirability of combining dimethicone and cyclomethicone with at least one block copolymer film former as presently claimed.

Accordingly, Applicant maintains that *DesLauriers* fails to teach or suggest compositions comprising at least one linear dimethicone, at least one cyclic dimethicone, and at least one block copolymer film former as presently claimed. As the cited references do not remedy the deficiencies of *DesLauriers*, Applicant respectfully requests the withdrawal of this rejection at least with respect to claim 29.

Claims 27 and 28

Claims 27 and 28 are drawn to compositions and methods of using compositions comprising at least one linear dimethicone, at least one cosmetic powder, and at least one block copolymer film former according to the present invention. *DesLauriers* does not teach such a composition nor does it provide the requisite motivation or suggestion, based on objective evidence of record, to make the specific combination as claimed in the present claims 27 and 28. For example, *DesLauriers* teaches that not only is dimethicone the worst emollient in terms of compatibility with *DesLauriers*' block copolymers, but it is also one of three worst components tested. Moreover, nowhere does *DesLauriers* teach or suggest at least one cosmetic powder.

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Accordingly, Applicant maintains that *DesLauriers* fails to teach or suggest compositions comprising at least one linear dimethicone, at least one cosmetic powder, and at least one block copolymer film former as presently claimed. As the cited references do not remedy the deficiencies of *DesLauriers*, Applicant respectfully requests the withdrawal of this rejection at least with respect to claims 27 and 28.

Claim 31

Claim 31 is drawn to a composition comprising at least one linear dimethicone in an amount ranging from 25% to 75% by weight relative to the total weight of the composition and at least one block copolymer film former according to the present invention. Applicant maintains that one of ordinary skill in the art would not have been motivated to modify the compositions of *DesLauriers* in such a manner necessary to arrive at the compositions of claim 31.

As discussed above, *DesLauriers* teaches in its sole disclosure of dimethicone that compositions comprising greater than 2 wt% dimethicone result in sample separation. See Table 11. Accordingly, *DesLauriers* teaches away from compositions comprising greater than 2 wt% dimethicone. However, the compositions of claim 31 comprise, *inter alia*, at least one linear dimethicone in an amount ranging from 25% to 75% by weight relative to the total weight of the composition.

For at least the foregoing reason, Applicant submits that one of ordinary skill in the art would not have been motivated to modify the compositions of *DesLauriers* in such a manner necessary to arrive at the compositions of claim 31.

III. **Conclusion**

Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extension of time under 37 C.F.R. § 1.136 required to enter this response and charge those additional fees to our Deposit Account No. 06-916.

Respectfully submitted,

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